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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/053,832	04/01/98	OWENS	W 28.733

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QM12/0328

EXAMINER	
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ART UNIT	**PAPER NUMBER**
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/053,832	Applicant(s) OWENS, WILLIAM M.	
	Examiner Charles Goodman	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

1)☒ Responsive to communication(s) filed on *10 January 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) *9-13* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)☐ All b)☐ Some * c)☐ None of the CERTIFIED copies of the priority documents have been:

1.☐ received.

2.☐ received in Application No. (Series Code / Serial Number) _____ .

3.☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

14) ☒ Notice of References Cited (PTO-892)
15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
17) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
18) ☐ Notice of Informal Patent Application (PTO-152)
19) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Species I, allegedly reading on claims 1-12, in Paper No. 5 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claim 13 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species II, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5 for the reasons stated *supra*. In addition, claims 9-12 have been withdrawn from further consideration since these claimed features are not shown in the elected species.

3. Based upon the above, claims 1-8 remain for consideration on the merits.

Information Disclosure Statement

4. Receipt is acknowledged of Applicant's submission of an IDS filed on April 1, 1998 along with the corresponding copies. However, Applicant failed to provide a PTO-1449 form for the Examiner to note consideration thereof. In lieu of this, the Examiner has included the references in the attached PTO Form-892. No copy of these references will be provided since it is apparent that Applicant is already in position of these references.

Specification

5. The disclosure is objected to because of the following informalities:

i. It is noted that in the specification, the line numbers on the left margin of the papers do not match with the actual lines. Thus, the following line number designations are referring to the *actual* line number(s) as it appears on the specified page rather than the ones shown in the left margin.

ii. P. 3, ll. 18-21, the use of the trademarks "Scandera Red Carbox Rough Top" and "Browning Manufacturing Company" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

iii. P. 3, l. 24 – p. 4, l. 1, the phrase "an inside feed roller on the input side (42)" should read -- an inside feed roller (42) on the input side --, since it would appear from the drawings that "42" represents the "feed roller" as opposed to the "input side." Other examples of this problem are (p. 4, l. 1) "feed roller at the input end (8)" should read -- feed roller (8) at the input end--; (p. 4, l. 2) "inside feed roller at the output end (43)" should read – inside feed roller (43) at the output end --; and (p. 4, ll. 2-3) "feed roller at the output end (34)" should read -- feed roller (34)

at the output end --. Applicant is advised to correct similar problems throughout the specification.

iv. P. 4, l. 15, the phrase "feed rollers" at the beginning of the line should read -- feed roller --.

v. P. 5, l. 13, the phrase "spring or pneumatic cylinder loaded arm (12, 18, 20, 45)" is not clearly understood. References "12" and "45" have been used to designate a "spring loaded arm", and now they are referred to as a "pneumatic cylinder loaded arm". Which is which? If the arms 18, 45 can also be "pneumatic cylinder", then it is suggested that this alternative be set forth during the first instance of the references so that the specification is clear.

Appropriate correction is required.

Claim Objections

6. The claims in this application do not commence on a separate sheet in accordance with 37 CFR 1.52(b). Appropriate correction is required in response to this action.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention. The claims are replete with vague and indefinite language and lack of antecedent basis for claimed features. The following are some noted examples. Applicant is advised to thoroughly review the claims for compliance with the above statute. Failure to do so will result in the next Office Action being FINAL.

i. The following phrases lack clear antecedent basis: (claim 1, ll. 4, 6, 9, and 12) "its length", "the position", and "their rate of movement"; (claim 2) "the length" and "their length"; (claim 3, l. 4) "the length of the non-skid continuous conveyor belt"; (claim 4) "the input side", "the input end", "the distance", "their faces", "the guide 'V' belt", "the bottom surface", and "the mounting means for the feed rollers" (to name a few in this claim alone);

ii. In claim 1, l. 4, the term "its" is vague and indefinite. What is "its" referring to? Substantially the same applies to all instances of similar terms in the claims. In addition, the phrase "a cutting means" is vague and indefinite in that it is a double inclusion of the same previously recited. In l. 6, the phrase "a direction parallel to its length" is also vague and indefinite in that it appears to be a double inclusion of the same previously recited. Applicant is advised to thoroughly review the claims such that they do not double include. See e.g. l. 11 and the recitation of the "belt means". In ll. 11-12, clause (e) is vague and indefinite in that it is not clear what the clause encompasses. What is the phrase "*in* input and an output..." (emphasis added) referring to?

iii. Claim 2 is vague and indefinite in that it is not clear what the claim encompasses. The claim is replete with double inclusions of features previously set forth. Substantially the same applies to claim 6.

iv. In claim 3, ll. 1-2, the phrase "said non-skid continuous conveyor belt means" is vague and indefinite in that it is not clear which "belt means" the phrase is referring to since claim 1 sets forth two different "belt means." In l. 4, the term "form" should read -- from --. In l. 6, the phrase "...as defined in Claim 1..." is vague and indefinite in that it is not clear what the phrase encompasses. What is the phrase referring to? Moreover, what is the difference, if any, between the "'V' groove" in the "drive means" and the "guide means" of the previous claim, since it appears that the "'V' groove" is more a part of the "guide means" than the "drive means"? If the Examiner is incorrect, then what is encompassed by the "guide means" of claim 1?

v. Claim 4 is vague and indefinite in that it is not clear what the claim encompasses. The claim is replete with lack of antecedent basis for claimed features as noted above which renders the scope of the claim unascertainable. Moreover, in ll. 5-6, the phrase "the non-skid continuous conveyor belt means" is vague and indefinite in that it is not clear which "belt means" the phrase is referring to since claim 1 sets forth two different "belt means." In addition, it appears that the claim is setting forth features that are common to two different "sides" of the apparatus,

yet the claim is not clear on this issue, i.e. the claim does not set forth the features for each input and output sides.

vi. Claim 7 is vague and indefinite in that it is not clear what the claim encompasses. First, it appears that some trademarked features are being claimed. If so, then they have not been properly identified. Note the specification objection *supra*. Second, if these are trademarked items, then the scope of the claim is not clearly understood when the trademarked items appear to be intellectual property right of a third party as opposed to Applicant.

vii. Claim 8 is vague and indefinite in that it is not clear what the claim encompasses. Majority of the recited features are double inclusions of the same previously recited. Moreover, the scope of the claim is unclear when it appears that the claimed apparatus now includes both "spring loaded" and "pneumatic cylinder loaded" are means. How so? Which disclosed embodiment included both?

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. As best understood, claims 1, 3-5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoffa.

Hoffa an apparatus for cutting wire comprising all the elements claimed including a powered cutting means (at 100 in Fig. 1); an input non-skid continuous conveyor belt means 13; an output non-skid continuous conveyor belt means 15; a hold down means 12, 14; a guide means (between the outer flanged portions of sprocket 44 – see, e.g., Figs. 1 and 5); drive means 56, 44, 47 that rotate both input and output conveyor belt means at the same RPM; the conveyor belt means including a material having the length, width, and a guide V-belt; the drive means including a V-groove (due to the sprocket design); a feed bed (see structure between the conveyor belt means in Fig. 1); an inside feed roller 44; a feed roller 45; a timing belt 50, 51; and the hold down means having a plurality of hold down rollers (see rollers at 14 in Fig. 1). See whole patent.

Regarding the work being a flat, rigid, cuttable material, this has not been given significant patentable weight, since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. As best understood, claims 1-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zimmerman in view of Chambers and Baranski.

Zimmerman discloses the invention substantially as claimed including powered cutting means 168a, 168b...172a, 172b; input conveyor means 36; output conveyor means 38; hold down means 98, 100, 102, 104, 110, 112 which include pneumatic cylinder loaded arm means 144; and drive means (Fig. 3). See also Figs. 1, 2, 5, and 7. However, Zimmerman lacks (1) the input and output conveyor means each being continuous belt means and (2) guide means.

Regarding (1), although Zimmerman lacks the input and output conveyor means each being continuous belt means, Chambers clearly teaches that continuous belt means are art recognized equivalent means of feeding work material to and out of the cutting station of a powered cutting means. More specifically, Chambers teaches, in a sawing device, an input non-skid continuous conveyor belt means 10 that move the to be cut material 12 to a cutting means 16, 18 and an output non-skid continuous conveyor belt means 20 that move the cut material 12' out of the cutting means which are the same functions as that of Zimmerman's conveyor means. See Fig. 1. Therefore, because these two input and output means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the input and output continuous conveyor belt means of Chambers for the input and output roller conveyor means of Zimmerman for the reasons stated *supra*.

Regarding (2), the modified device of Zimmerman discloses the invention substantially as claimed except for guide means. However, Baranski teaches, in a resaw device, a guide means 114, 116, 122, 124 that maintains the position of a non-skid continuous conveyor belt

means 80 relative to the cutting means due to the conveyor belt means having a guide V-belt 156 riding in V-grooves 124, 122 on an inside feed roller 128 and a feed roller 126, respectively, and a V-groove 120 on a feed bed 114, 116 wherein all these features prevent lateral movement of the conveyor belt during rotation thereof. See. Figs. 4-5, c. 4, l. 22-68. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the modified device of Zimmerman with the guide means as taught by Baranski in order to facilitate positive guidance and accurate positioning of each of the continuous conveyor belt means by preventing lateral movement of the conveyor belt means during the longitudinal movement of the conveyor belt means.

Regarding the work being a flat, rigid, cuttable material, this has not been given significant patentable weight, since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claim 6, the phrase "capable of being set..." has not been given significant patentable weight, since it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

13. As best understood, claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zimmerman in view of Chambers and Baranski as applied to claims 1-6 and 8 above, and further in view of Conrad.

The modified device of Zimmerman discloses the invention substantially as claimed including the thickness of the belt means. However, Zimmerman, modified, lacks the scallop shaped cuts.

First, it is noted that the thickness and the composition of the continuous conveyor belt and notch grip belts (which include the scallop shaped cuts) are disclosed as commercially available materials and thickness for a conveyor belt having a guide V-belt. As such these are deemed obvious to one of ordinary skill in the art. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the modified device of Zimmerman with the physical and material characteristics of the conveyor belt as claimed since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Second, even if Applicant argues to the contrary, Conrad teaches a continuous conveyor belt means wherein the belt includes guide V-belts (e.g. 34) having scalloped shaped cuts (Fig. 2) for the purpose of maximizing the flex of the belt. See c. 1, ll. 61-65. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the modified device of Zimmerman with the scallop shaped cuts in the guide V-belts as taught by Conrad in order to maximize the flex experienced by the conveyor belt means during movement thereof. Moreover with regards to the thickness and the material of the belt, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the modified device of Zimmerman with the thickness and the material as claimed in order to provide the belt with

optimum thickness and frictional characteristics for the desired conveyance and work environment, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art, *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), and since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Conclusion

14. Cannaday, Smitterberg et al, Dunham, Masse, Taylor, Mowery et al, Pierce, and Askue are cited as pertinent art. In addition, the following references are also cited in order to make of record the references that the Applicant wishes consideration thereof in the IDS that Applicant submitted in April 1, 1998 without a corresponding PTO-1449. As noted *supra*, NO COPY of the following references will be provided: Head Jr. et al, Jenkner, Jones et al, Oppeneer, Moilanen, Fornell et al, Idelsohn et al, and Schroder.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (703) 308-0501. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached on (703) 308-2187. The fax phone number for this Group is (703) 305-3579.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to **[rinaldi.rada@uspto.gov]**.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

Charles Goodman
Patent Examiner
AU 3724

cg
March 25, 2000